

**Remarks**

This is in response to the Final Office Action dated **April 8, 2009**. Claims 1-26 and 58-60 are pending in this application. The Office Action rejected claims 1, 5, 6, 18-20 and 60 under 35 USC § 103 over Matthews (US 4739769) in view of Wolvek (US 4276874); rejected claims 2-4, 7-10 and 14 under 35 USC § 103 over Matthews in view of Wolvek and further in view of Fulton (US 6074374); rejected claim 11 under 35 USC § 103 over Matthews in view of Wolvek and Fulton and further in view of Follmer (US 5728065); rejected claims 12, 13, 15 and 17 under 35 USC § 103 over Matthews in view of Wolvek and further in view of Follmer; rejected claims 16 and 58 under 35 USC § 103 over Matthews in view of Follmer and Chee (US 5906606); rejected claims 21-24 under 35 USC § 103 over Matthews in view of Wolvek and further in view of Imran (US 5766203); rejected claims 25 and 26 under 35 USC § 103 over Matthews in view of Wolvek and further in view of Hamilton (US 6514228); and rejected claim 59 under 35 USC § 103 over Matthews in view of Wolvek and Follmer and further in view of Chee.

The rejections asserted in the Office Action are traversed. Applicants request reconsideration in view of the following remarks.

**Claim Rejections**

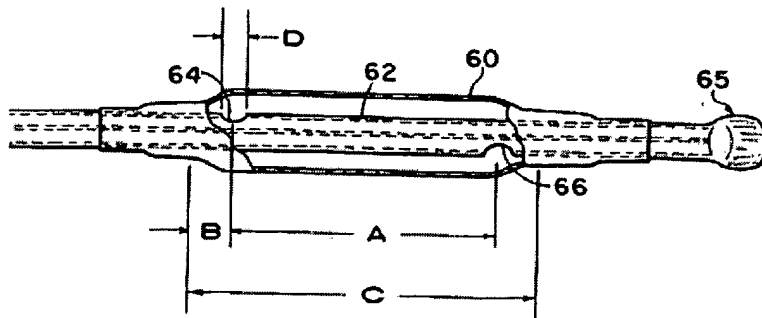
The rejections asserted in the Office Action are traversed. The rejections are discussed below with respect to the independent claims.

**Independent Claim 1**

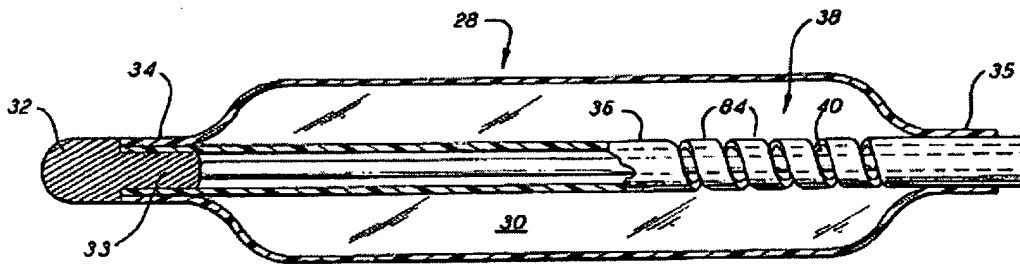
Claim 1 stands rejected over Matthews in view of Wolvek. Various dependent claims stand rejected under Matthews and Wolvek combined with additional references.

Claim 1 recites “a catheter tip having a guidewire lumen extending therethrough.”

Neither Matthews nor Wolvek discloses or suggests a catheter tip with a guidewire lumen. See e.g. Figure 6 of Mathews and Figure 6 of Wolvek, provided below.



Matthews *Fig. 6*



Wolvek *FIG. 6*

“Obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003).

Claim 1 is patentable over Matthews and Wolvek because the combination does not disclose or suggest each limitation of claim 1.

Further, a person of ordinary skill in the art would not have modified Matthews as proposed in the rejection. Claim 1 recites, “each recessed portion extending around a full outer periphery of the catheter tip.” The rejection characterizes Matthews’ inflation holes 64, 66 as “recessed portions,” and proposes to modify the holes to extend around the periphery of the catheter in a manner similar to the helical slit 40 disclosed by Wolvek. See Office Action at page 2.

The modification proposed in the rejection would interfere with the function of the Matthews device and render it unsuitable for its intended purpose of determining tissue pressure.

If the proposed modification would render the prior art invention being modified

unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Matthews Figure 6, recreated below, illustrates a preferred embodiment of the Matthews catheter. See e.g. column 3, lines 51-52. The inflation holes are placed with specific dimensions that allow the device to operate. For example, Matthews states, "Care must be exercised that the hole 64 is not too close to the end so that any change in compliance due to the sealing will not change the compliance of the bubble 60. The design, having the measurements shown, has worked satisfactorily...." See column 6, lines 3-22.

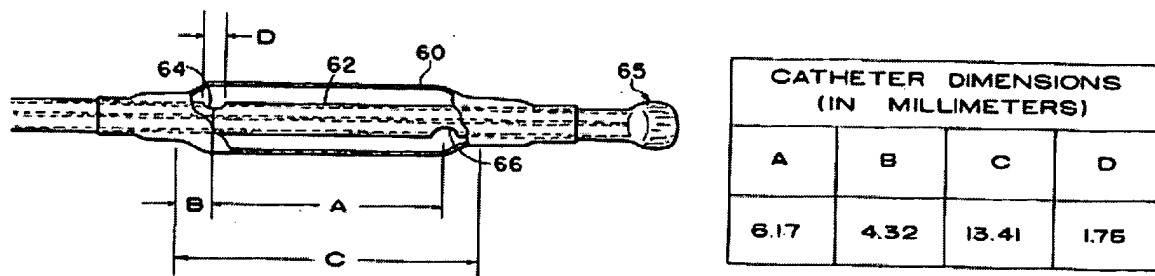


Fig. 6

Modifying Matthews as proposed in the rejection would modify the dimensions of the device and interfere with operation. Further, it should be noted that each hole 64, 66 is in fluid communication with a separate fluid lumen. Changing the holes 64, 66 such that they extend about a full periphery of the catheter would allow fluid communication between the lumens at each modified hole, thereby defeating the device's ability to properly determine tissue pressure.

Therefore, the rejection has not identified a reason that would have actually prompted a person of ordinary skill in the art to modify Matthews as proposed, and claim 1 is patentable over Matthews and Wolvek under 35 USC § 103. Claims that depend from claim 1 are patentable over Matthews and Wolvek for at least the reasons discussed with respect to claim 1.

With respect to the Fulton, Follmer, Imran and Hamilton references, cited against various dependent claims, the Office Action does not propose any modifications to the prior art that would result in a device with a catheter tip having a guidewire lumen extending therethrough, as recited in claim 1. Therefore, the Office Action has not presented a *prima facie* case of unpatentability against any of claims 1-15, 17-26 and 59-60. Applicants request withdrawal of the rejections asserted against these claims.

**Independent Claim 16**

Claim 16 stands rejected over Matthews in view of Follmer and Chee.

Claim 16 recites, “wherein said second region comprises entrained stiffening fibers selected from a group consisting of polypropylene fibers and polyolefin fibers.”

“Obviousness requires a suggestion of all limitations in a claim.” CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003).

The applied references do not disclose or suggest the materials recited in claim 16. The Office Action admits that Matthews and Follmer do not disclose or suggest the recited materials, but asserts that Chee renders the recited materials obvious. See Office Action at page 5.

The rejection cites to Chee column 7, lines 32-34, which recites, “Suitable nonmetallic ribbons or wires include materials such as those made of polyaramides (Kevlar), polyethylene terephthalate (Dacron), or carbon fibers.”

Thus, Chee teaches polyaramides, polyethylene terephthalate and carbon fibers; however, a person of ordinary skill in the art would recognize that Chee does not disclose “polypropylene fibers” or “polyolefin fibers” as recited in claim 16. Therefore, claim 16 is patentable over Matthews in view of Follmer and Chee under 35 USC § 103.

Claim 58 depends from claim 16 and is patentable over Matthews in view of Follmer and Chee for at least the reasons discussed with respect to claim 16. Applicant requests withdrawal of the rejections directed to claims 16 and 58.

**Information Disclosure Statement**

(to be entered upon reopening of prosecution or reversal of rejection)

European Patent 1708775 claims priority to the immediate application. On December 22, 2008, the EPO issued a notice of opposition to the patent filed by Abbott Labs. The opposition brief cites references not of record in the US application, which Applicants are disclosing to the USPTO in this Information Disclosure Statement.

The immediate application is currently under final rejection – as such, an IDS would not be considered. Applicants submit the IDS now to disclose the references to the

USPTO, and request that the IDS be entered immediately when possible – for example upon either a reopening of prosecution or upon the reversal of a claim rejection by the Board of Appeals.

Upon entering the IDS, please charge any fees associated with the IDS to Deposit Account No. 22-0350.

A list of references cited in the opposition brief, as well as an English translation of the opposition brief, is attached to the IDS.

### **Conclusion**

Based on at least the foregoing remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-26 and 58-60 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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